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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,721	01/24/2001	Tatsuhiko Ikuta	1614.1115	3663
21171	7590	02/14/2008		
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER KHATTAR, RAJESH	
			ART UNIT	PAPER NUMBER
			3693	
			MAIL DATE	DELIVERY MODE
			02/14/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

**Application No.**

09/767,721

**Applicant(s)**

IKUTA, TATSUHIKO

**Examiner**

RAJESH KHATTAR

**Art Unit**

3693

***--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --***

THE REPLY FILED 28 January 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: \_\_\_\_\_.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.  
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_.

/James A. Kramer/  
Supervisory Patent Examiner, Art Unit 3693

Examiner has carefully reviewed Applicant's arguments with respect to the rejections of claims 1-14 under 35 U.S.C. 103(a). Examiner provides a clear explanation of how prior art teaches the claimed invention.

Applicant states that "the Office action's citation to 6 columns and four Figures of Chiles fails to designate the particular part of the reference as nearly as practicably, namely, the term "license" is not found on Chiles." Applicant further states that "the rejection fails to meet the requirements to clearly explain the pertinence of each reference, because it is unclear how a software updating application relates to, or disclose (either expressly or implicitly), the claimed "when the license file is not determined to be valid and a user at the terminal device agrees to update the license file, access to the accounting server is carried out based on the registration certification, notification of charging is made to the accounting server and, after the completion of the charging, access to the contents is continued and a new license file received from the accounting server is installed." Examiner explains the rejection as follows:

As previously explained in the Office Action dated 11/3/2006 and repeated on 5/15/2007 and 10/31/2007, that Michel teaches the act of checking validity of number of uses of a software program (col. 8, lines 24-32). However, Michel does not expressly teach certificates and licenses. However, these aspects of the invention are taught by Lampson ([0093], Figures 9, 11). Thus, a combination of Michel and Lampson teaches:

"when the license file is not determined to be valid, access to the accounting server is carried out, notification of charging is made to the accounting server and, after the completion of the charging, access to the contents is continued".

The motivation to combine these two references would be to utilize the pay per use protection technique for the unauthorized use of the computer software as evidenced by Michel (Abstract).

However, Applicant further amended the claims (on 3/2/2007 and 9/17/2007) to include "and a user at the terminal device agrees to update the license file...based on the registration certification..... and a new license file received from the accounting server is installed". Thus the amended limitation states:

"when the license file is not determined to be valid and a user at the terminal device agrees to update the license file, access to the accounting server is carried out based on the registration certification, notification of charging is made to the accounting server and, after the completion of the charging, access to the contents is continued and a new license file received from the accounting server is installed."

Since Lampson does teach certificates and license, Examiner cites Chiles disclosing "a user at the terminal device agrees to update the file and a new file received from the accounting server is installed. Thus, a combination of elements disclosed by Lampson and Chiles would teach the following:

".....a user at the terminal device agrees to update the license file, ..... based on the registration certification, ..... a new license file received from the accounting server is installed."

In order to address whether combining these elements would be obvious to a person having ordinary skills in the art at the time the invention was made, Examiner notes that Lampson discloses that "The DRMOS determines if the application's use of the content is permitted under the license 223". Lampson also states that the license 223 places restriction on the use on the use of the content 221 ([0091]), [0093] and [0066]. This lead the Examiner to conclude that in Lampson the access to the content will not be allowed if the license is determined to be invalid. If that is the case, then the license has to be renewed in order to gain access to the content. In this regard, Chiles discloses a user at the terminal device agree to update the product from the server on to his (her) computer (col. 1, lines 60-63; col. 14, lines 63-67) and a new file is received. Lampson teaches downloading a license 223 to the DRMOS 205 ([0091]). Therefore, the combination of Lampson and Chiles would teach

".....a user at the terminal device agrees to update the license file, .. based on the registration certification, ...a new license file received from the accounting server is installed."

One would have been motivated to combine Lampson and Chiles in order to update the file as taught by Chiles.

Thus, a combination of Michel, Lampson and Chiles teaches the limitation:

"when the license file is not determined to be valid and a user at the terminal device agrees to update the license file, access to the accounting server is carried out based on the registration certification, notification of charging is made to the accounting server and, after the completion of the charging, access to the contents is continued and a new license file received from the accounting server is installed."

One would have been motivated to combine the disclosure of Michel, Lampson with the disclosure of Chiles in order for the user-initiated update for the software product to take place as evidenced by Chiles (col. 14, lines 63-67).